



PATENT

Docket No.: M4065.0132/P132-A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
Eugene P. Marsh

Application No.: 09/594,171

Filed: June 15, 2000

For: OXIDATION RESISTANT PLATINUM
FILM FOR CAPACITORS

Examiner: G. C. Eckert

Group Art Unit: 2815

Confirmation No.: 8887

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APR 8

REPLY BRIEF

Sir:

This Reply Brief is responsive to the Examiner's Answer dated May 14, 2004. A Request for Oral Hearing is being filed concurrently herewith.

As noted in the main Brief, each claim on appeal recites a "uniform" platinum metal group film. This is an important aspect of the claimed invention. The Examiner contends that the recited uniformity is shown in Fig. 3 of Xing. Appellant respectfully submits, however, that the recited film uniformity is not taught by Xing. Xing does not say that the electrode 304 has a uniform structure. Xing's Fig. 3 is not a working drawing or a photomicrograph of a semiconductor product. It is merely a draftsperson's representation of a hypothetical cross-section. There is nothing in the document to indicate that the line drawings are meant to

designate a uniform film structure for the electrode 304. It is well settled that the drawings of U.S. patents show merely “simulated” representations of products, not the actual products themselves. In re Klein, 987 F.2d 1569, 1574 (Fed. Cir. 1993); In re Betz, 166 F.2d 831, 833 (C.C.P.A. 1948) (“patent drawings are not working drawings”).

Further, each claim on appeal says that the recited film has an “essentially carbon-free” structure. This is another important aspect of the claimed invention. Xing fails to teach or suggest that the electrode 304 is “essentially carbon-free.” Xing says nothing about the carbon content, whatever it might be, of the electrode 304.

The Examiner says it is “inherent that [Xing’s] electrode is essentially free of carbon,” “because carbon is detrimental to the device.” This contention has no support in the prior art of record. There is nothing in the prior art to indicate that capacitor electrodes like the electrode 304 of Xing are “inherently” “essentially free from carbon.”

Further, the Examiner argues, in effect, that Appellant should be precluded from pursuing product claims (claims to a capacitor). The claimed invention should not be so limited by the specification, however, and please note that Appellant has pursued claims to a capacitor *per se* since its earliest effective filing date (see original, now cancelled, claims 58-61). The assertion that Appellant has relied “solely on the asserted novel method of manufacture,” is without merit, and should have nothing to do with the disposition of this appeal.

Further, the Examiner attempts to argue that Appellant’s own application somehow teaches that it was well known to provide the recited “uniform” and “essentially carbon-free” electrode. Contrary to the Examiner’s Answer, the Appellant does not admit it was known to provide the recited “uniform” and

“essentially carbon free” electrode. The application illustrates the “conventional methods” in Fig. 1. There is no showing or description of a platinum group metal film that is “uniform” and “essentially carbon-free.”

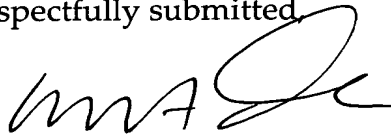
The Examiner tries to turn Appellant’s description of the known art on its head. The application says, for example, that “in the conventional . . . methods it is *difficult* to create a continuous uniform platinum film with good step coverage” (emphasis added). Although the application uses the word “difficult,” this does not mean that the claimed invention was already known. The specification refers to decreasing the temperature at which platinum group metal precursors were deposited to make a more uniform film. As explained in the same specification, however, a consequence of decreasing the temperature was a high carbon content. Also discussed in the specification is the addition of oxygen to decrease the amount of carbon. The addition of oxygen, however, would increase the deposition rate of the metal, resulting in more non-uniformity.

Finally, Appellant does not understand why the Examiner has appended the so-called Ruska document to the Examiner’s Answer. The document is not part of any rejection, nor is it of record, and in substance it appears to be totally unrelated to any of the issues in this appeal.

In conclusion, Appellant respectfully submits that the Final Rejection of claims 79-82 and 85-92 is in error for at least the reasons given in the Appeal Brief and for at least the further reasons stated above and should, therefore, be reversed.

Dated: July 14, 2004

Respectfully submitted,

By 

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